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BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

First Named Inventor	:	Granville R. Fairchild
Serial No.	:	10 / 716,781
Filed	:	11-18-2003
Art Unit	:	2165
Examiner	:	Syed, Farhan M
Title	:	METHOD AND APPARATUS PROVIDING OMNIBUS VIEW OF ONLINE AND OFFLINE CONTENT OF VARIOUS FILE TYPES AND SOURCES
Attorney Docket No.	:	AOL0157

Honorable Commissioner of Patents & Trademarks
MAIL STOP : APPEAL BRIEF - PATENTS
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BRIEF ON APPEAL

Applicant's Appeal Brief follows.

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REAL PARTY IN INTEREST

The subject application has been assigned to America Online, Incorporated by assignment recorded in the U.S. Patent & Trademark Office on May 14, 2004 at Reel / Frame 015340 / 0509.

RELATED APPEALS AND INTERFERENCES

There are no prior and pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claim 1 – rejected

Claim 2 – rejected

Claim 3 – objected-to

Claim 4 – rejected

Claim 5 – rejected

Claim 6 – objected-to

Claim 7 – rejected

Claim 8 – rejected

Claim 9 – objected-to

Claim 10 – rejected

Claim 11 – rejected

Claim 12 – objected-to

Claim 13 - rejected

STATUS OF AMENDMENTS

No amendments have been made after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise Explanation of Subject Matter

As recommended by MPEP 1206, the following summary of the invention comprises reading of each appealed independent claim on the drawings and specification, to enable the Board to more determine where the claimed subject matter appears in the application. This particular reading is not intended to limit the claims in any way.

Independent Claim 1

A method for operating an online service facility (ref. 111, FIG. 1) selectively accessed by multiple member computers (ref. 102, FIG. 1), the online service facility including a plurality of online data centers (ref. 112B-112F, FIG. 1) operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the method comprising operations of: (page 12, line 5 – page 16, line 20)

providing an aggregated catalog (ref. 112A, FIG. 1) that contains information including: (1) metadata identifying members' data objects residing in the

data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members; (ref. 404, FIG. 4)

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage; (ref. 408, FIG. 4)

updating the aggregated catalog to list the newly stored data objects from the online data centers and member computers' local storage; (ref. 406, FIG. 4)

responsive to each request by a member, searching (ref. 502, FIG. 5) the aggregated catalog and utilizing results of the search to provide an output (ref. 502, FIG. 5) for display at the requesting member's computer, the output comprising a consolidated listing of both online data objects and locally stored data objects owned by the requesting member.

Independent Claim 7

Data management equipment for use in an online service facility (ref. 111, FIG. 1) selectively accessed by multiple member computers (ref. 102, FIG. 1), the online service facility including a plurality of online data centers (ref. 112, FIG. 1) operated by an online service provider (OSP) to store members' data objects (ref. 112B-112F) relating to a variety of online services that the OSP renders to its members, the equipment comprising:

an aggregated catalog (ref. 112A, FIG. 1) that contains information including: (1) metadata identifying members' data objects (ref. 112B-112F, FIG. 1) residing in the data centers, and (2) metadata identifying members' data objects (ref. 102B, FIG. 1) residing in local storage of respective member computers (ref. 102, FIG. 1);

an aggregator (ref. 108, FIG. 1) programmed to perform operations comprising: (page 12, line 5 – page 16, line 20)

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members; (ref. 404, FIG. 4)

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage; (ref. 408, FIG. 4)

updating the aggregated catalog to list to include metadata identifying the newly stored data objects contained in the online data centers and local storage; (ref. 410, FIG. 4)

a finder (ref. 109, FIG. 1) programmed to perform operations comprising, (page 12, line 5 – page 16, line 20) responsive to request by a member, searching (ref. 502, FIG. 5) the aggregated catalog and utilizing results of the search to provide an output (ref. 502, FIG. 5) for display at the requesting member's computer, the output comprising a consolidated listing of online data objects and locally stored data objects owned by the requesting member.

Independent Claim 13

Data management equipment for use in an online service facility (ref. 111, FIG. 1) selectively accessed by multiple member computers (ref. 102, FIG. 1), the online service facility including a plurality of online data centers (ref. 112, FIG. 1) operated by an online service provider (OSP) to store members' data objects (ref. 112B-112F) relating to a variety of online services that the OSP renders to its members, the equipment comprising:

aggregated catalog means (ref. 112A, FIG. 1) for storing information including:

(1) metadata identifying members' data objects (ref. 112B-112F, FIG. 1) residing in the data centers, and (2) metadata identifying members' data objects (ref. 102B, FIG. 1) residing in local storage of respective member computers (ref. 102, FIG. 1);

aggregator means (ref. 108, FIG. 1) for: (page 12, line 5 – page 16, line 20)

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members; (ref. 404, FIG. 4)

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage; (ref. 408, FIG. 4)

updating the aggregated catalog means to include metadata identifying the data objects newly stored data objects contained in the data centers and local storage; (ref. 410, FIG. 4)

finder means (ref. 109, FIG. 1) for, (page 12, line 5 – page 16, line 20)

responsive to each request by a member, searching (ref. 502, FIG. 5) the aggregated catalog means and utilizing results of the search to provide an output (ref. 502, FIG. 5) for display at the requesting member's computer, the output comprising a consolidated listing of online data objects and locally stored data objects owned by the member.

Dependent Claims

As to the dependent claims in the application, the Rules do not require a summary of claimed subject matter referenced against the specification of drawings. This is true whether or not the dependent claims are argued independently.

In particular, Rule 41.37 requires a concise summary of the subject matter defined in independent claims. 37 CFR 41.37(c)(v) (first sentence). As for dependent claims, the "structure, material, or acts described in the specification... must be set forth with reference to the specification... and drawing..." in the case of means plus function or step plus function claims. 37 CFR 41.37(c)(v) (second sentence).

Therefore, the Rules do not require a concise summary of the subject matter defined in dependent claims if they are not means plus function or step plus function claims. Reference is directed to 37 CFR 41.37(c)(v) and MPEP 1205.02.

The present application does not contain any means plus function or step plus function dependent claims.

And, as for the independent claims, a concise summary (with extensive references to the specification and drawings) appears above. Accordingly, the

requirement of providing a concise summary of claims has been satisfied.

Identification of Means Plus Function & Step Plus Function Claims

In accordance with 37 CFR 47.37(c)(1)(v), the following is an identification of all independent and separately argued dependent claims in means (or step) plus function as permitted by 35 USC 112 para. 6: Claim 13 only.

Corresponding structure, material, and acts are found in the text and drawings as specifically identified in the concise summary above.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- Whether claims 1, 4, 7, 10, 13 are patentable under 35 USC 103 over U.S. Patent No. 6,804,674 to Hsiao et al. ("Hsiao") in view of U.S. Patent No. 6,878,384 to Johnson et al. ("Johnson '384").
- Whether claims 2, 8, are patentable under 35 USC 103 over the combination of Hsiao, Johnson '384, and U.S. Patent No. 5,805,858 to Kumamoto et al. ("Kumamoto").
- Whether claims 5, 11 are patentable under 35 USC 103 over the combination of Hsiao, Johnson '384, and U.S. Patent No. 5,964,839 to Johnson et al. ("Johnson '839").

ARGUMENTS

35 USC 101 REJECTIONS: CLAIMS 7, 13

Introduction

The final office action rejected these claims as being directed to non-statutory subject matter. This rejection is untenable. The claims are patentable under section 101 since the Examiner has not set forth the mandatory *prima facie* case of unpatentability, as explained below.

Claims 7, 13 Define Statutory Subject Matter

As the Supreme Court held, Congress chose the expansive language of 35 USC 101 to include "anything under the sun that is made by man."[1] "The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103 and 112. The use of the expansive term 'any' in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations."[2]

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture, or composition of

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1 *Diamond v. Chakrabarty*, 447 US 303, 308-309, 206 USPQ 193, 197 (1980).

2 *In re Allapat*, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994)

matter). In many instances it is clear within which of the enumerated categories a claimed invention falls.[3] In the present case, claims 7 and 13 concern machines ("data management equipment"). Right away, then, claims 7 and 13 clearly fall within a specifically enumerated category of patentable subject matter.

Nor do the claims fall within judicial exceptions to section 101, such as abstract ideas, natural phenomena, and laws of nature. Clearly, the claims are rife with real-word details of practical application, such as online data centers, member computers, catalogs, metadata, storage of data objects, providing an output for display at a member computer, etc. Furthermore, the Examiner failed to allege (let alone explain how) the claims are purportedly reduced to an abstract idea, natural phenomena, or law of nature as required by the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.[4]

Accordingly, the claims are fully compliant with 35 USC 101, and concern abundantly statutory subject matter.

The Office Actions Fail to Set Forth a Prima Facie Case of Unpatentability

In the final office action dated 10-19-2006, the Examiner considered Applicant's arguments with respect to claims 7 and 13 but deemed them to be unpersuasive. Accordingly, Applicant understands that the rejections as set forth in the 4-27-2006, and their supporting reasoning, are being maintained.

Although the Examiner's line of reasoning (fully stated in full in the 4-27-2006

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3 USPTO Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, page 15.

office action) is not fully comprehended, the 4-27-2006 office action proposes that "a signal bearing medium is not tangible, and cannot tangibly embodying a computer program or process." "A computer cannot understand/realize (i.e., execute) the computer program or process when embodied on the data signal." [Office Action of 4-27-2006: page 5] In this regard, the 4-27-2006 office action suggests that a data signal does not meet the "useful, concrete, and tangible" requirement. [Office Action of 4-27-2006: page 5]

First, the Examiner's leap to the "useful, concrete, and tangible" requirement was premature. The Examiner failed to discuss whether/how the claims fall within a section 101 judicial exception, such as a law of nature, natural phenomena, or abstract idea. Clearly, they do not. Rather, the claims are rife with real word details of practical application, such as online data centers, member computers, catalogs, metadata, storage of data objects, providing an output for display at a member computer, etc. Furthermore, even "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be."[5] Moreover, "[i]n evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself."[6]

Second, Applicant disputes the Examiner's suggestion that a computer cannot

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4 *Id.*, at 14.

5 *Id.*, at 17-18.

understand/realize (i.e., execute) the computer program or process when embodied on the data signal, and that a data signal does not meet the "useful, concrete, and tangible" requirement. "[F]rom a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal."[7] There has been no citation of proper legal authority to suggest otherwise.

Along these lines, the Examiner notes that, when using a carrier wave to execute programming instructions, it cannot tangibly produce a result, thus rendering the claims indefinite. [Office Action of 10-19-2006: page 4] The nature of the storage medium is irrelevant, however, since the claims do not concern the storage medium *per se*, and a computer achieves the same result by executing computer-readable instructions regardless of the form in which the instructions are embodied. In other words, if the result is tangible, then the format of storing the instructions simply does not matter. In the present situation, the result is abundantly tangible as discussed above. For example, see claim 7, which claims "an aggregator programmed to perform operations comprising.. monitoring contents of the data centers... communicating with the member computers... updating the aggregated catalog..."

Third, even if (for the sake of argument) a data signal does not meet the "useful, concrete, and tangible" requirement, this is not relevant to the claims. The claims at

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6 *Id.*

7 *Id.* at 57.

issue are not aimed at a signal bearing medium. Rather, the claims at issue are aimed at a statutory apparatus, described in terms of data management equipment. In the case of claim 7, the subject matter includes an aggregated catalog, an aggregator (programmed to perform certain operations), and a finder (programmed to perform certain other operations). Claim 13 includes similar features. If a machine is programmed in a certain new and unobvious way, "it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. If a new machine has not been invented, certainly a 'new and useful improvement' of the unprogrammed machine has been, and Congress has said in 35 U.S.C. 101 that such improvements are statutory subject matter for a patent."[8]

Moreover, the Examiner admitted that "while communicating with the member computers, a transmission of data occurs, where the prescribed types of data are transmitted from the member computer's local storage to the on-line data centers." [Office Action of 4-27-2006: page 4] Transmission of data from a member computer's local storage to an on-line data center is clearly statutory subject matter, undercutting any argument that the claims are nonstatutory.

As such, claims 7 and 13 are patentable as-is, because the rejection of these claims fails to provide a *prima facie* case of unpatentability as required. The Examiner should be overruled, and the rejection under 35 USC 101 reversed.

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[8] *In re Bernhart and Fetter*, 163 USPQ 611 (CCPA 1969).

35 USC 103 REJECTIONS: CLAIMS 1, 4, 7, 10, 13

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Hsiao and Johnson '384. The claims are patentable since a *prima facie* case of obviousness does not exist, as discussed in greater detail below.[9]

Teaching/Suggestion of Claim Limitations

Introduction

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.[10] To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.[11]

All words in a claim must be considered in judging the patentability of that claim against the prior art.[12]

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9 MPEP 2142.

10 MPEP 2142, 2143.03.

11 *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

12 *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

Claims 1, 17, 13

Taking claim 1 as an example, the proposed combination of references fails to teach the following combination:

A method for operating an online service facility selectively accessed by multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the method comprising operations of:

providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members;

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage;

updating the aggregated catalog to list the newly stored data objects from the online data centers and member computers' local storage;

responsive to each request by a member, searching the aggregated catalog and utilizing results of the search to provide an output for display at the requesting member's computer, the output

comprising a consolidated listing of both online data objects and locally stored data objects owned by the requesting member.

As a more particular example, claim 1 is patentably distinguishable from the applied art because the applied art does not show the claimed combination including **"providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers."**

The final office action proposes that this feature is found in Hsiao's col. 10, lines 49-53. [Office Action of 10-19-2006: page 11] However, Hsiao does not teach "metadata identifying members' data objects residing in local storage of respective member computer" as claimed.

Hsiao's Figure 1 is said to show an exemplary overall environment in which a scalable content management system 10 of the present invention may be used. [Hsiao: col. 8, lines 17-19] In Hsiao's Figure 1, users, such as remote Internet users are represented by a variety of computers such as computers 37, 39, and can query a content management system 10 for the desired information. [Hsiao: col. 8, lines 32-35; Fig. 1] However, Hsiao fails to disclose any members' data objects residing in local storage of users' computers such as 37, 39. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao's Figure 2 is said to show an exemplary high level architecture showing the scalable content management system of Figure 1 used in the context of an Internet

search. [Hsiao: col. 8, lines 49-51] Although Hsiao's Figure 2 purportedly shows a user's web browser, there is no discussion of any data objects residing in local storage of the user's computer where the web browser is installed. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao's Figure 4 is said to show a process of using a scalable content management system. [Hsiao: col. 9, lines 58-61] Although Hsiao's step 405 purportedly illustrates a search for documents, and step 410 shows a search of metadata and file system, there is no teaching that the search includes any data objects residing in local storage of respective member computers.

Similarly, Hsiao's Figure 5 is said to show a block diagram representation of the scalable content management system, where the scalable content management system 10 provides connectivity to a client 505, such as a web client or an end user, who is connected to the service provider 100 (FIG. 2) via the network 20. [Hsiao: col. 10, lines 23-28] Although Hsiao's Figure 5 shows various clients (such as a web client or an end user), there is no illustration or discussion of data objects residing in local storage of the user's computer where the web browser is installed. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao suggests that its eContent manager is a building block that can be used to build a personal content manager on a small home PC. Alternatively, Hsiao mentions that the eContent manager may be implemented in a highly powered and highly scalable web and/or enterprise content server. [Hsiao: col. 4, lines 12-19] Nevertheless, Hsiao does not suggest combining the personal content manager with the enterprise content server, nor does Hsiao illustrate any mechanism for doing so.

Although Hsiao makes mention of a local content manager and a plurality of remote content managers, both local and remote content managers are part of the network-accessible content management system 10. [Hsiao: col. 8, lines 17-48] Moreover, Hsiao's parallel query manger 615 must combine the local search results from the content search and parametric search, if both exist; the manager 614 may also be awaiting the remote search results from the remote content managers 650. In case of remote search results, both the local and the remote search results 655 are merged or appended, and returned to the user. [Hsiao: col. 12, lines 5-10] This is inconsistent with (and teaches away from) the claimed aggregated catalog.

Accordingly, Hsiao does not teach the claimed operation of "providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers."

The final office action admits that Hsiao lacks the claimed operation of **"monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members."** [Office Action of 10-19-2006: page 12] Instead, the final office action proposes that this feature is found in the Abstract of Johnson '384. [Office Action of 10-19-2006: page 13] However, Johnson '384 is focused at monitoring inbound and outbound information activity at the household level, such as monitoring real-time interaction between an on-line service and a household to reveal information about the type of information being accessed or the time of day a particular service is accessed. [Johnson '384: col. 2, lines 36-41] Johnson '384 seeks to monitor and collect inbound/outbound information activity and communications

activity at a particular user location, such as a household equipped with a variety of devices having communications capabilities. [Johnson '384: col. 2, lines 57-62] Johnson '384 is said to collect information concerning user operation of a software package, such as the time of loading the software package, total usage time of the application, types of files accessed or types of functions accessed by the user. [Johnson '384: col. 2, lines 43-51]

Johnson '384 is therefore focused on the household, rather than contents of online data centers as claimed. And, although Johnson '384 specifically discusses various types of information activity mentioned above, Johnson '384 fails to mention "new storage of prescribed types of data objects owned by the members" as claimed. Accordingly, Johnson '384 does not teach the claimed feature "monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members."

The applied art also lacks the claimed operation of **"communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage."** As discussed in detail above, Hsiao does not contemplate data objects stored on member's computers.

The applied art also lacks the claimed operation of **"updating the aggregated catalog to list the newly stored data objects from the online data centers and member computers' local storage."** The Examiner proposes that this feature is found in Hsiao's col. 3, lines 21-15 and col. 4, lines 51-54. [Office Action of 10-19-2006: page 11] However, the final office action already admits that Hsiao does not teach "monitoring contents of the data centers to detect new storage of prescribed

types of data objects owned by the members" as discussed above. For this reason, Hsiao necessarily fails to show "updating the aggregated catalog to list the newly stored data objects from the online data centers..." In fact, Hsiao teaches away from the claimed aggregated catalog by teaching a completely different approach, as discussed above.

The applied art also lacks the claimed operation of **"responsive to each request by a member, searching the aggregated catalog and utilizing results of the search to provide an output for display at the requesting member's computer, the output comprising a consolidated listing of both online data objects and locally stored data objects owned by the requesting member."** As mentioned above, the applied art does not teach the claimed aggregated catalog, so the operation of "searching the aggregated catalog..." is similarly missing from the art.

In view of the foregoing, the features of claim 1 are absent from Hsiao and Johnson '384. Further, for similar reasons, independent claims 7 and 13 are patentably distinguished from the applied art.

Claims 4, 10

Even without considering any individual merits of claims 4 and 10, these claims are distinguished from the applied art because they depend from independent claims that are distinguished as discussed above.[13]

Nonetheless, as an example of certain features of these dependent claims that

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[13] If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

further distinguish over the applied art, claims 4 and 10 are discussed. Namely, the applied art fails to show **"during display of the consolidated listing at the member's computer, updating the display substantially in real time to reflect any data objects that are of prescribed types, owned by the member, and newly stored in the online data center during the display."** The Examiner proposes that the features of claims 4, 10 are found in Johnson '384. [Office Action: pages 13-14] As discussed in detail above, however, Johnson '384 is focused on the household, rather than contents of online data centers as claimed. Furthermore, Johnson '384 does not demonstrate any concern with "new storage of prescribed types of data objects owned by the members" as claimed.

Moreover, Johnson '384 does not show "display of the consolidated listing at the member's computer" and "updating the display substantially in real time..." as claimed. Again, Johnson '384 is concerned with market research, and particular monitoring user activity, such as capturing data regarding household purchases or access of product or market data from electronic sources. [Johnson '384: col. 2, lines 24-31] From this standpoint, it does not make sense why Johnson '384 would display such information about the user at the user's computer. Johnson '384's household information is clearly collected for use and display by entities other than the household user him/herself. Accordingly, for a number of reasons Johnson '384 does not teach the claimed feature "display of the consolidated listing at the member's computer" and "updating the display substantially in real time..." as claimed.

Suggestion or Motivation

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.[14]

The final office action suggests that it would have been obvious to modify Hsiao with the teachings of Johnson '384 "to include a method for monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members." [Office Action of 10-19-2006: page 13] This suggestion is untenable because, as mentioned above, Johnson '384 does not teach this feature.

As motivation to make the suggested combination, the final office action cites a desire to "provide the functions needed for content creation, storage, search, management, and distribution." [Office Action of 10-19-2006: page 13] However, according to Hsiao, the "scalable content management system of the present invention provides several functions, among which are the following... a single scalable content manager will provide the functions needed for content creation, storage, search, management, and distribution." [Hsiao: col. 4, line 56 – col. 5, line 15] Therefore, according to Hsiao's own disclosure, Hsiao's already satisfies the need identified in the final office action. Lacking from the references is any motivation to modify Hsiao's system by incorporating any features from Johnson '384. The Examiner's purported motivation merely suggests using Hsiao's system as taught by Hsiao.

Accordingly, the *prima facie* case of obviousness is lacking since there has been

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14 MPEP 2142.

no showing of the legally required suggestion or motivation to modify the reference or to combine reference teachings.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the Examiner failed to show that there would be a reasonable expectation of success in modifying/combining references.[15] The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.[16] If the examiner does not produce a prima facie case, the applicant is under *no* obligation to submit evidence of nonobviousness.[17] Critically, to establish a *prima facie* case of obviousness, *there must be a reasonable expectation of success.*[18] This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.[19]

The final office action lacks any evidence, allegation, or other mention of the legally required "reasonable expectation of success." Accordingly, the *prima facie* case of obviousness is incomplete.

Conclusion as to Claims 1, 4, 7, 10, 13

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15 MPEP 2142, 2143.02.

16 MPEP 2142.

17 *Id.*

18 MPEP 2143.

19 *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

35 USC 103 REJECTIONS: CLAIMS 2, 8

Claims 2, 8 were rejected under 35 USC 103 as being unpatentable over the combination of Hsiao, Johnson '384, and Kumamoto.

Even without considering the individual merits of these claims, they are patentably distinguished over the proposed combination because they depend from independent claims that are allowable over Hsiao and Johnson '384 (as discussed above), and Kumamoto fails to provide the features missing from Hsiao and Johnson '384. For instance, in the example of claim 1, Kumamoto still does not show the claimed combination including operations of "providing an aggregated catalog..." "monitoring contents of the data centers..." or "communicating with member computers.." or "updating the aggregated catalog..." or "searching the aggregated catalog..." as discussed above. Instead, the Examiner introduced Kumamoto simply to show a member-activated VIEW feature. [Office Action dated 10-19-2006: page 15]

35 USC 103 REJECTIONS: CLAIMS 5, 11

Claims 5, 11 were rejected under 35 USC 103 as being unpatentable over the

combination of Hsiao, Johnson '384, and Johnson '839.

Even without considering the individual merits of these claims, they are patentably distinguished over the proposed combination because they depend from independent claims that are allowable over Hsiao and Johnson '384 (as discussed above), and Johnson '839 fails to provide the features missing from Hsiao and Johnson '384. For instance, in the example of claim 1, Johnson '839 still does not show the claimed combination including operations of "providing an aggregated catalog..." "monitoring contents of the data centers..." or "communicating with member computers.." or "updating the aggregated catalog..." or "searching the aggregated catalog..." as discussed above. Instead, the Examiner introduced Johnson '389 simply to show a monitoring operation carried out by communicating with data centers to identify data objects contained therein. [Office Action of 10-19-2006: page 16]

CONCLUSION

For the foregoing reasons, the claims in the present application are clearly and patentably distinguished over the cited references. Accordingly, the Examiner should be reversed and ordered to pass the case to issue.

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method for operating an online service facility selectively accessed by multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the method comprising operations of:

providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members;

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage;

updating the aggregated catalog to list the newly stored data objects from the online data centers and member computers' local storage;

responsive to each request by a member, searching the aggregated catalog and utilizing results of the search to provide an output for display at the requesting member's computer, the output comprising a consolidated listing of both online data objects and locally stored data objects owned by the requesting member.

2. The method of claim 1, where:

the consolidated listing includes a member-activatable VIEW feature;

the operations further comprise, responsive to activation of the VIEW feature in conjunction with a particular one of the listed data objects, activating software to present contents of the particular data object to the member.

3. The method of claim 1, where:

the consolidated listing includes a member-activatable SHARE feature;

the operations further comprise, responsive to activation of the SHARE feature in conjunction with a particular one of the listed data objects, activating software to share the particular data object with a member-designated transferee.

4. The method of claim 1, where the operations further comprise:

during display of the consolidated listing at the member's computer, updating the display substantially in real time to reflect any data objects that are of prescribed types, owned by the member, and newly stored in the online data center during the display.

5. The method of claim 1, where the monitoring operation is carried out by at least one of the following operations:

communicating with the data centers to identify data objects contained therein;

monitoring members' activities conducted while accessing the online service facility.

6. The method of claim 1, where:

the operations of searching the searching the aggregated catalog and utilizing results of the search to provide an output are performed by an online finder;

the operations further comprise employing software at the requesting member's computer to display the output.

7. Data management equipment for use in an online service facility selectively accessed by multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the equipment comprising:

an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

an aggregator programmed to perform operations comprising:

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members;

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage;

updating the aggregated catalog to list to include metadata identifying the newly stored data objects contained in the online data centers and local storage;

a finder programmed to perform operations comprising, responsive to request by a member, searching the aggregated catalog and utilizing results of the search to provide an output for display at the requesting member's computer, the output comprising a consolidated listing of online data objects and locally stored data objects owned by the requesting member.

8. The equipment of claim 7, where the finder is further programmed such that:

the consolidated listing includes a member-activatable VIEW feature;

the operations performed by the finder further comprise, responsive to activation of the VIEW feature in conjunction with a particular one of the listed data objects, activating software to present contents of the particular data object to the member.

9. The equipment of claim 7, where the finder is further programmed such that:

the consolidated listing includes a member-activatable SHARE feature;

the operations performed by the finder further comprise, responsive to activation of the SHARE feature in conjunction with a particular one of the listed data objects, activating software to share the particular data object with a member designated transferee.

10. The equipment of claim 7, where the finder is further programmed to perform operations comprising:

during display of the consolidated listing at the member's computer, updating the display substantially in real time to reflect any data objects that are of prescribed types, owned by the member, and newly stored in the online data center during the display.

11. The equipment of claim 7, where the aggregator is programmed such that the monitoring operation is carried out by at least one of the following operations:

communicating with the data centers to identify data objects contained therein;

monitoring members' activities conducted while utilizing the online service facility.

12. The equipment of claim 7, where:

the finder comprises one or more processing entities at the online service facility;

the equipment further includes local interface software installed at the member computers, programmed to display the output.

13. Data management equipment for use in an online service facility selectively accessed by multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members'

data objects relating to a variety of online services that the OSP renders to its members, the equipment comprising:

aggregated catalog means for storing information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

aggregator means for:

monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members;

communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage;

updating the aggregated catalog means to include metadata identifying the data objects newly stored data objects contained in the data centers and local storage;

finder means for, responsive to each request by a member, searching the aggregated catalog means and utilizing results of the search to provide an output for display at the requesting member's computer, the output comprising a consolidated listing of online data objects and locally stored data objects owned by the member.

EVIDENCE APPENDIX

(none)

RELATED PROCEEDINGS APPENDIX

(none)